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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,589	11/24/2003	Francis J. Marentic	126.12-0003	5782

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EXAMINER

SHEWAREGED, BETELHEM

ART UNIT PAPER NUMBER

1774

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/721,589

Applicant(s)

MARENTIC ET AL.

Examiner

Betelhem Shewareged

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4-7,9,10,41-47 and 49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-7,9,10,41-47 and 49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Applicant's response along with the Request for Continued Examination (RCE) filed on 10/03/2006 has been fully considered. The rejection under 35 USC 102 as being anticipated by Yamauchi, and the claim objections have been withdrawn in view of Applicant's amendments and comments.

2. Claims 1, 6, 7, 9, 10, 41-47 and 49 are amended, claims 2, 3, 8, 11-40 and 48 are canceled, and claims 1, 4-7, 9, 10, 41-47 and 49 are pending.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 4-9, 10, 41-47 and 49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1, 41-44, 47 and 49 are amended to include a peroxide catalyst in the ink film and/or in the clear gel layer; however, there is no support in the specification. The claimed ink film and clear gel layer are the first and second intermediate layers. The specification clearly discloses that the intermediate layers of the decorative transfer do not contain catalyst (page 6, line 13 and page 14, line 10). In the embodiment that the color gel coat layer is

Art Unit: 1774

used as the first intermediate layer (i.e., the ink film), the color gel coat layer contains no catalyst (page 26, lines 17-21). The catalyst may be contained in the color gel coat layer; however, the color coat gel layer is additional layer that may be provided over the first and the second intermediate layer (col. 4, line 21; col. 6, line 16; col. 9, line 3; col. 28, line 26; col. 36, line 14 and col. 38, line 26). Since the specification does not provide a support for the peroxide catalyst to be contained in any of the first and second intermediate layers, the limitation of the peroxide catalyst to be contained in the ink film and/or clear gel coat layer has not been given patentable weight.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 4, 6, 7, 9, 10, 41-47 and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by Kobayashi et al. (US 5,643,659), as evidenced by Rinz (US 6,040,391), Ogawa et al. (US 5,959,035), Kamimura et al. (US 5,663,116) and List of Organic Solvent Copolyester resins (Internet Printout).

7. Kobayashi discloses a transfer sheet comprising a substrate sheet, a coloring layer comprising a coloring agent and a hot-melt binder, and a metallic ink layer comprising a metallic pigment and a hot-melt binder (abstract). The coloring layer is equivalent to the claimed first layer and the metallic ink layer is equivalent the claimed

Art Unit: 1774

second layer. Both the coloring layer and the metallic layer comprise polyester as the binder (201. 2, line 62 and col. 3, line 44). The amount of coloring agent in the coloring layer is 5-100 parts by weight for 100 parts by weight of the binder (col. 3, line 29). In the Examples the binder used in the metallic layer is polyester of Vylon 200 manufactured by Toyobo Co., Ltd., wherein this polyester has adhesive property, which is evidenced by List of Organic Solvent Copolyester resins. Furthermore, the polyester of Vylon 200 is crosslinkable. Even though, Kobayashi does not expressly disclose that the polyester in the metallic layer is crosslinkable, the polyester is crosslinkable, and the evidence is shown in Ogawa and Kamimura. In Ogawa the polyester is curable because Ogawa discloses curability test with "very good" result (see Example 2 and Table 1 in col. 7 and col. 8 of Ogawa). Kamimura teaches the use of crosslinking agent in a coating liquid containing polyester of Vylon, wherein the crosslinking agent will harden the resin in the coating liquid (see coating liquid (1) of Example 1 and coating liquid (2) of Example 5 of Kamimura). With respect to claims 7 and 43, polyester is a condensation product of polybasic acid such as isophthalic acid and polyol such as neopentyl glycol, and this is evidenced by Rinz (see col. 2, lines 35-59 of Rinz).

### **8. Claim Rejections - 35 USC § 103**

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. (US 5,643,659).

11. Kobayashi does not disclose the use of a release liner over the metallic ink layer. However, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to cover the adhesive layer of Kobayashi with a release liner so as to keep the metallic ink layer from being damaged while handling and/or storing. Protecting an outer layer with a release liner is well known in the transfer medium art.

### ***Response to Arguments***

12. Applicant's arguments with respect to claims 1, 4-7, 9, 10, 41-47 and 49 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

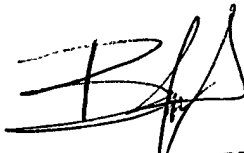
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 571-272-1529. The examiner can normally be reached on Mon.-Fri. 8:00AM-4:30PM.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1774

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

B.S.  
November 18, 2006.



BETELHEM SHEWAREGED  
PRIMARY EXAMINER